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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,161	08/10/2001	Maria R. Diaz-Torres	GC627-2	3999

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GENENCOR INTERNATIONAL, INC.
ATTENTION: LEGAL DEPARTMENT
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PALO ALTO, CA 94304

EXAMINER

SHIBUYA, MARK LANCE

ART UNIT

PAPER NUMBER

1639

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/927,161

Applicant(s)

DIAZ-TORRES ET AL.

Examiner

Mark L. Shibuya

Art Unit

1639

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): New Matter rejection; see attached sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1,4-7 and 9-12.

Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


PADMASHRI PONNALURI
PRIMARY EXAMINER

Mark L. Shibuya
Examiner
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Applicant's amendments to the claims after final rejection, filed 8/20/2004, are not entered. Applicant's amendments would raise new issues that would require further consideration and search. It is respectfully noted that the amendment after final of claim 1 would replace the term "non-heterologous" with "non-homologous". Because claim 1 was significantly amended in the Reply, filed 4/19/2004, to the first Office action on the merits, mailed 10/20/2003, the proposed amendment to claim 1 would result in a claim that was not been examined in the previous Office action, mailed 7/27/04 or in the first Office action on the merits, mailed 10/20/2003. Thus the proposed amendment to claim 1 would not place the application in condition for allowance and would require additional consideration and search.

In regards to the rejection of the claims under 35 U.S.C. 112, second paragraph, applicant traverses the rejection; however applicant does not specify the reasons for said traversal.

In regards to the maintained rejection of the claims under 35 U.S.C. 112, first paragraph, for lack of written description, applicant traverses the rejection, stating that the specification as filed meets the requirement for written description. Applicant points to the Figures as teaching varying non-homologous flank length. Figure 11 discloses non-homologous flanking regions of ~2 kb and ~1.5 kb. Applicant's arguments have been considered but are not considered persuasive, because the Specification does not provide representative examples of different sizes or of non-homologous or non-heterologous DNA flanking sequences or varying degrees of homology or non-homology to convey possession of the claimed invention.

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In regards to the maintained rejection of the claims under 35 U.S.C. 112, first paragraph, for *new matter*, applicant's proposed amendment to claim 1 would appear to remove the ground of rejection for claim 1 and dependent claim 12. However, issues regarding additional consideration and search would still apply, (see above).

In regards to the rejection of the claims under 35 U.S.C. 112, first paragraph, for lack of enablement, applicant traverses the rejection; however applicant does not specify the reasons for said traversal.